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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,652	07/09/2003	Kristian DiMatteo	1001.1309103	9311
28075	7590	08/07/2006	EXAMINER YABUT, DIANE D	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			ART UNIT 3734	PAPER NUMBER

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/615,652	<b>Applicant(s)</b> DIMATTEO, KRISTIAN	
	<b>Examiner</b> Diane Yabut	<b>Art Unit</b> 3734	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) 27-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-26 and 34-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/27/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 20-26 and 34-40, drawn to a filtering device, classified in class 606, subclass 200.
  - II. Claims 27-32, drawn to a method for making a filtering device, classified in class 606, subclass 198.
  - III. Claim 33, drawn to a method for using a filtering device, classified in class 606, subclass 194.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as dip-molding.
3. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and

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materially different process such as one that involves electrolytic corrosion to break the filtering member at a weakened region.

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility that does not involve breaking the weakened region by applying a force. See MPEP § 806.05(d).

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

7. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

8. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the

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record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

9. During a telephone conversation with Glenn Seager on Friday, July 28, 2006 a provisional election was made without traverse to prosecute the invention of Group I directed towards Claims 20-26 and 34-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-33, which are directed towards Groups II and III, are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

#### ***Information Disclosure Statement***

10. The information disclosure statement (IDS) submitted on 27 October 2003 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Drawings***

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In Figure 6 the reference character "102" should instead be "112" and reference 100 should instead be "110" as indicated on page 11, line 12 of the description; In Figure 8, reference character "102" should instead be "110" or some other reference numeral since "110" is designated to retrieval catheter 110 in Figure 6

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as indicated on page 13, line 15, in which case the description should be altered accordingly. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

12. The disclosure is objected to because of the following informalities: As mentioned in paragraph 2 above, on page 13, line 15, it reads "force transfer member 110" which is not shown in any of the figures, although it appears to be directed to the hook member in Figure 8 that is referenced as "102," and therefore should be changed to 102 in the specification, although it is suggested that both the drawing and specification should be changed and include another reference numeral since "102" is designated to lumen 102 of retrieval catheter 100.

Appropriate correction is required.

### ***Double Patenting***

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. **6,217,600**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass the same invention.

15. Claim 20 recites “a filtering device comprising a body member,” and “a plurality of struts coupled to the body member and extending therefrom,” as well as “one or more of the struts include a weakened region” (see lines 1-4 of Claim 20).

The difference between Claim 20 of the application and Claim 1 of the patent lies in the fact that the patent claim includes more elements and is thus much more specific. Thus the invention of Claim 1 of the patent is in effect a “species” of the “generic” invention of

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Claim 20. It has been held that the generic invention is "anticipated" by the "species".

See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since Claim 20 is anticipated by Claim 1 of the patent, it is not patentably distinct from Claim 1.

### ***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

17. Claims 20-23, 25-26, 34-36, and 38-40 are rejected under 35 U.S.C. 102(a) as being anticipated by **Ravenscroft et al.** (U.S. Patent No. **6,007,558**).

Claims 20-23, 25, 34, and 38-40: Ravenscroft et al. discloses a conically-shaped filtering basket including an apex, comprising a body member **12**, a plurality of struts, or arms, **26** that are substantially straight and have a distal, or first, end region and a proximal, or second, end region wherein the proximal end region is coupled to the body member with the struts extending therefrom, a plurality of anchoring members **28** disposed on a distal end of each of the struts, and a weakened region, or reduced cross-sectional area region, **30** defined in each of the struts adjacent the anchoring member (Figures 1-2).

Claim 26: Ravenscroft et al. discloses the struts having bends **42** (Figure 10).



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Claims 35-36: Ravenscroft et al. discloses the reduced cross-sectional area region **30** being defined by a notch or divet, wherein a “notch” and a “divet” are both understood as meaning an “indentation” (Figure 2).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ravenscroft et al.** (U.S. Patent No. **6,007,558**) in view of **El-Nounou et al.** (U.S. Patent No. **5,242,462**).

Claim 24: Ravenscroft et al. discloses the claimed device except for the body member including a bore.

El-Nounou et al. teaches a filter device with a body member **62** having a bore **68** which is beneficial in receiving a guidewire during manipulation of the filter (Figure 7 and col. 4, lines 51-53, col. 2, lines 35-42). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a bore in the body member, as taught by El-Nounou et al., to Ravenscroft et al. in order to manipulate the filter device by a guidewire or hook.

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20. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ravenscroft et al.** (U.S. Patent No. **6,007,558**) in view of **Ambrisco et al.** (U.S. Patent No. **6,007,557**).

Claim 37: Ravenscroft et al. discloses the claimed device except for the reduced-cross sectional area being defined by an opening in the strut.

Ambrisco et al. teaches a reduced cross-sectional area defined by an opening **318** in a strut **312** which can be useful in allowing a guidewire or hook to pass through for manipulation of the filter device (Figure 36C and col. 20, lines 1-15). It would have been obvious to one of ordinary skill in the art at the time of invention to provide an opening in the strut, as taught by Ambrisco et al., to Ravenscroft et al. in order to manipulate the filter device by a guidewire or hook.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **DeVries** (U.S. Patent No. **6,342,063**) discloses anchor portions separated by a filter device using electrolytic corrosion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "M J Hayes", is positioned above the printed name.

MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER